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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,923	07/22/2003	Akira Kashiwagi	89277.0004	7123
26021	7590	09/06/2005		
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611			EXAMINER NEGRON, ISMAEL	
			ART UNIT 2875	PAPER NUMBER

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/624,923	Applicant(s) KASHIWAGI, AKIRA	
	Examiner Ismael Negron	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7,9-11,13,14 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 11 and 13 is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7,9,10,14 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Response to Amendment

2. Applicant's amendment filed on July 14, 2005 has been entered. Claims 1, 5, 11 and 14 have been amended. Claims 2, 6, 8, 12, 15 and 16 have been cancelled. No claim has been added. Claims 1, 3-5, 7, 9-11, 13, 14 and 17-21 are still pending in this application, with claims 1, 5, 11 and 14 being independent.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the at least one lens having a directivity that causes light emitted by the light emitting elements to be redirected in the horizontal direction (as recited in claims 1, 5, 11 and 14) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4, 9 and 19-21 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 4 is indefinite as it is not clear if the claimed invention relates to a tail lamp device (as previously recited in Claim 1), or the combination of a tail lamp and motorcycle rear fender (as implied by the newly recited rear fender limitations). Claims 9 and 21 are rejected for similar reasons.

The applicant is advised that in the comparing the claimed invention with the Prior Art, the Examiner assumed that the claimed invention relates to a tail lamp (as stated by claims 1, 5 and 14), and not a combination of a tail lamp and a motorcycle rear fender.

7. Claim 19 is indefinite as it is not clear if the limitation "further comprising a circuit substrate having circuit elements" defines a circuit substrate in addition to the previously claimed circuit substrate (Claim 14, line 17), or if it merely introduces new circuit elements mounted on the circuit substrate of Claim 14.

The applicant is advised that in the comparing the claimed invention with the Prior Art, the Examiner assumed that the claimed invention features only one circuit substrate with Claim 19 merely adding circuit elements to such one circuit substrate. If the Examiner's assumption is in error, the applicant is further advised that claims 19 and 20 would still be indefinite since the recitation "the circuit substrate" (Claim 19, line 3 and Claim 20, lines 1 and 2) fails to positively identify which one of the two circuit

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substrates it is referring to. Claim 20 is also rejected for its dependency on rejected Claim 19.

8. Claim 20 is indefinite as it is not clear how can the circuit substrate be covering the concave section of the housing and at the same time enclose itself inside such concave section.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 3-5, 7, 9, 10, 14 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over SASAJIMA et al. (U.S. Pat. 5,241,457).

10. SASAJIMA et al. discloses an illumination device having :

- **a tail lamp (as recited in claims 1 and 5),** Figure 5, reference number 51;
- **a lamp substrate (as recited in claims 1, 5 and 14),** Figure 5, reference number 56;

- **a plurality of light emitting elements (as recited in claims 1, 5 and 14), Figure 5, reference number 55;**
- **the light emitting elements being mounted on the lamp substrate (as recited in claims 1, 5 and 14), as seen in Figure 5;**
- **the light emitting elements being aligned in the same direction substantially perpendicular to the lamp substrate (as recited in claims 1, 5 and 14), as seen in Figure 5;**
- **the light emitting elements being aligned upwardly and diagonally relative to a horizontal direction (as recited in Claim 1), as seen in Figure 5;**
- **at least one lens (as recited in claims 1, 5 and 14), Figure 5, reference number 58;**
- **the lens covering the plurality of light emitting elements (as recited in claims 1, 5 and 14), as seen in Figure 5;**
- **the lens having directivity to cause light from the light emitting elements to be redirected in the horizontal direction (as recited in claims 1, 5 and 14), column 5, lines 10-15;**
- **the light emitting elements being light emitting diode (LED) elements (as recited in claims 3, 7 and 18), column 4, lines 61 and 62;**
- **the tail lamp being mountable on a rear fender of a motorcycle (as recited in claims 1, 5 and 21), inherent;**

- **circuit elements for the light emitting elements (as recited in claims 4 and 9), as evidenced by Figure 2 and column 3, lines 48 and 49;**
- **the circuit elements being mounted on the lamp substrate (as recited in Claim 4), as evidenced by Figure 2 and column 3, lines 48 and 49;**
- **the lamp substrate being disposed along a slope surface angled from a vertical line (as recited in Claim 5), as seen in Figure 5;**
- **the light emitting elements emitting light in a direction angled from an horizontal line (as recited in claims 5 and 14), column 5, lines 10-15;**
- **a circuit substrate (as recited in claims 9 and 14), Figure 5, reference number 59;**
- **the circuit elements being mounted on the circuit substrate (as recited in claims 9 and 19), column 5, lines 16-25;**
- **the lamp substrate covering the circuit substrate (as recited in Claim 10), as seen in Figure 5;**
- **a housing (as recited in Claim 14), Figure 5, reference number 51;**
- **the lamps substrate being fastened to the housing (as recited in Claim 14), as seen in Figure 5;**

- **the lamp substrate being tilted from a vertical line when the housing is mounted on a vehicle (as recited in Claim 14), as seen in Figure 5;**
- **the lens being fastened to the housing (as recited in Claim 14), as seen in Figure 5;**
- **the housing having a concave section (as recited in Claim 14), as seen in Figure 5;**
- **the concave section protruding outwardly from a bottom surface of the housing (as recited in Claim 14), as seen in Figure 5;**
- **the circuit substrate being for the light emitting elements (as recited in Claim 14), column 5, lines 16-19;**
- **the circuit substrate being affixed to the housing below the lamp substrate (as recited in Claim 14), as seen in Figure 5;**
- **the light emitting elements emitting light diagonally with respect to the horizontal direction (as recited in Claim 17), column 5, lines 10-15; and**
- **the circuit substrate covering the concave section of the housing (as recited in Claim 20), as seen in Figure 5.**

11. SASAJIMA et al. discloses all the limitations of the claims, except:

- **the light emitting elements extending from the lamp substrate (as recited in claims 1 and 5);**

- a rear fender including a mounting concave section (as recited in claims 4, 9 and 21);
- the circuit elements being positioned in the mounting concave section (as recited in claims 4 and 9);
- the circuit substrate being placed inside the concave section of the housing (as recited in Claim 18);
- the circuit substrate being placed inside the concave section of the housing (as recited in Claim 19); and
- the concave section of the housing being positioned in the mounting concave section (as recited in Claim 21).

12. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to configured the LED to extend from the lamp substrate instead of being embedded in such substrate as in the patented structure of SASAJIMA et al., since it has been held by the courts that a change in shape or configuration, without any criticality, is nothing more than one of numerous shapes/configurations that one of ordinary skill in the art will find obvious to provide based on the suitability for the intended final application/purpose. See *In re Dailey*, 149 USPQ 47 (CCPA 1976). It appears that the disclosed device would perform equally well configured as disclosed by SASAJIMA et al.. It is noted that the specification is silent as to any reason or advantage provided by configuring the light emitting elements to extend from the lamp substrate.

13. Regarding the circuit elements being positioned in a mounting concave section of the rear fender of a motorcycle (as recited in claims 4 and 9), or the concave section of the housing being positioned in the mounting concave section (as recited in Claim 21), such limitations were considered having no patentable weight as they amount to a recitation of the intended use of the patented invention, without resulting in any structural difference between the claimed invention and the structure disclosed by SASAJIMA et al., and therefore fails to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Allowable Subject Matter

14. Claims 11 and 13 are allowed.

15. The following is an examiner's statement of reasons for allowance:

Applicant teaches a motorcycle rear fender including a tail lamp, the tail lamp having a plurality of light emitting elements mounted on a lamp substrate, with each of the light emitting elements extending in a diagonal direction relative to the horizontal direction. A lens covers the light emitting elements and redirects light from such elements in the horizontal direction. The rear fender includes a concave mounting section for receiving a circuit substrate for the light emitting elements below the lamp substrate.

No prior art was found teaching individually, or suggesting in combination, all of the features of the applicants' invention, specifically the claimed tail light in combination with a motorcycle rear fender having a concave mounting portion for receiving a light emitting elements circuit substrate disposed below the lamp substrate.

16. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

17. Applicant's arguments with respect to claims 1, 3-5, 7, 9-11, 13, 14 and 17-21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.


lnr

August 30, 2005



THOMAS M. SEMBER
PRIMARY EXAMINER